

REMARKS**I. Introduction**

Applicants would like to thank the Examiner for the indication of allowance of claims 1, 3, 6-8, 18-20, 22-24, 26 and 27. In response to the Office Action mailed May 26, 2004, Applicants have amended claims 1, 6 and 18 in the manner suggested by the Examiner so as to address the pending claim objections. Applicants have also amended claim 9 so as to further clarify the claimed subject matter. Support for this amendment can be found, for example, in Figs. 1 and 2, and their corresponding section of the specification. No new matter has been added.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art references.

II. The Rejection Of The Claims Under 35 U.S.C. § 102

Claim 9 is rejected under 35 U.S.C. § 102 as being anticipated by USP No. 6,137,183 to Sako. Applicants respectfully traverse this rejection for at least the following reasons.

Claim 9 recites, in part, an electronic part mounting element comprising at least two external electrodes, wherein each of the external electrodes of the electronic part is electrically connected to a connecting terminal of an element on which said electronic part is to be mounted, the coating operative as a connecting element for connecting each of the external electrodes to the connecting terminal.

Further, claim 9, as amended, recites that each end of the electronic part is surrounded with one of the external electrodes such that each external electrode covers

the entire end of the electronic part. In contrast to the present invention, Sako discloses the bumps 2 that are formed on the same side of the IC chip 1. It does not appear that the bumps 2 cover the entire end of the IC chip 1. Thus, at a minimum, Sako does not disclose or suggest that each end of the electronic part is surrounded with one of the external electrodes such that each external electrode covers the entire end of the electronic part, as recited by amended claim 9.

Thus, as anticipation under 35 U.S.C. § 102 requires that each element of the claim in issue be found, either expressly described or under principles of inherency, in a single prior art reference, *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983), and at a minimum, Sako fails to disclose or suggest the foregoing claim elements, it is clear that Sako does not anticipate claim 9 or any of the claims dependent thereon.

III. Conclusion

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited.

If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the

09/747,976

filing of this paper, including extension of time fees, to Deposit Account 500417 and
please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP



Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W.
Washington, DC 20005-3096
202.756.8000 MEF/AHC
Facsimile: 202.756.8087
Date: August 24, 2004